

REMARKS / ARGUMENTS

Remaining Claims

Fifteen (15) claims (Claims 1, 3 – 10, and 12 – 17) remain pending in this application.

Rejection of Claims 1, 3, 6, 16 and 17 under 35 USC §103(a) – Ono

Claims 1, 3-10 and 12-16 were rejected by the Examiner as being unpatentable over various primary and secondary references. Each and every rejection, however relies upon Japanese Patent No. JP 408129954A, hereafter referred to as the Ono patent.

Regarding claims 1 and 16, the Examiner relies on Ono for disclosure of a “UV ray lamp 8 including a light emitting part surrounded by optical fibers.” The combination of Ono and Martin would not have been obvious to one of skill in the art. Primarily, the Ono reference is non-analogous art and is not properly considered when determining the obviousness of the claimed invention. See, e.g. *Jurgens v. McKasy*, 18 USPQ2d 1031, 1036 (Fed. Cir. 1991). Two criteria are used to determine whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed; and (2) if the reference is not in the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Ono is not in the same field of endeavor (contact lens manufacture) nor is it reasonably pertinent. Furthermore, it is the Examiner’s burden to prove it as such. *In re Clay*, supra.

Even if Ono was pertinent art, there is no motivation or suggestion to combine it with the present application. Hence, it would not have been obvious to combine Martin with Ono.

Additionally, the Ono reference states that the intensity of the light is reduced, which is contrary to the purpose of the present invention. Hence, the Ono patent is not sufficient to provide a teaching or suggestion of a “plurality of optical fibres, wherein each optical fibre is linked to one casting mould,” as is required by the claims of the present invention.

Regarding claim 3, the Examiner rejected Martin et al. in view of Ono for “the UV lamp being a mercury lamp. As stated previously, Ono is not a proper reference for the UV lamp being surrounded by a plurality of optical fibers because it is non-analogous art.

Regarding claim 6, the Examiner states that "Martin et al in view of Ono does not teach the UV lamp operating at the claimed emission spectrum 280-360...It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the UV illumination system of Martin et al ('845) in view of Ono for its operation at the emission spectrum of 280-360..." As stated previously, the Ono reference reduces the intensity of the light, which shows that there is no teaching or suggestion to combine these references. Applicants respectfully requests that these rejections be reconsidered and withdrawn.

The Examiner rejected claim 4 as being unpatentable over Martin in view of Ono and further in view of Biller. Aside from the arguments made for independent claim 1, which cover all of the dependencies from claim 1, Biller is not an appropriate reference because it is non-analogous art. Biller is entitled "Radiation Curing of Powder Coatings on Wood." Although Biller mentions doped lamps, these lamps are used to cure powders on wood. Such a use is outside the inventor's field of endeavor. Using such lamps in the contact lens industry would not be obvious to one of skill in the art. Moreover, there is no motivation to combine Biller with any of the aforementioned references. Using hindsight to combine references is not permissible. As such, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Regarding claims 5, and claims 7, 8, and 12-14, the Martin and Ono references, as stated previously, should not be combined as they are non-analogous, their combination is not taught or suggested and would not have been obvious to one of skill in the art. Because claims 5,7,8, and 12-14 depend from claim 1, which should now be found allowable, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Regarding claims 9 and 10, besides those arguments already made, the combination of Martin, Ono, and Gonser (the '344 reference) would not have been obvious to one of skill in the art, nor is there a teaching or suggestion to combine these references. Gonser is directed to applications that are "biologically safe for applications in dentistry" '344 patent, col. 2, line 7. Moreover, Gonser does not teach a "quartz rod 55 positioned between the UV lamp and the light admission area of each of the optical fibers." Primarily, item 55 in Gonser is a light guide, not a quartz rod. Additionally, the only quartz component mention in Gonser is a sealed bulb or envelope that is part of a halogen lamp. Gonser has thus been mischaracterized. The current placement of the

cut-on filter, contrary to the Examiner's statement cannot be merely rearranged as this would involve further positioning of other components because the UV lamp of the present invention reaches a temperature of more than 800 degrees C. The lamp in Gonser reaches temperatures around 250 degrees C. As such, merely repositioning engineering components is not an easy or obvious solution.


Regarding claim 15, there is no teaching or suggestion to combine this reference with Ono or Martin. Primarily, the Sopori reference is related to a solar stimulator that is designed to produce the entire solar spectrum for testing purposes. The entire solar spectrum includes both UV and visible light – It would be illogical to use this type of technology in conjunction with any UV curing system. Applicants respectfully request that this rejection be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the 35 USC § 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not anticipated by or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



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